

examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP 803 (emphasis added).

MPEP 803 provides that “[e]xaminers must provide reasons and/or examples to support conclusions” (Emphasis added.) The Office Action has not given sufficient reasons and/or examples in support of the imposition of this restriction requirement. According to MPEP 806.05(e), “[p]rocess and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.” (Italics in original and emphasis added.) The Office Action contends that “the process as claimed [in claims 29-40] can be practiced by another materially different apparatus, such as one not having a transfer wheel, a star wheel, or a turret.” Office Action, Page 2, Lines 13-15. Nevertheless, Applicant maintains that the Office Action has failed to describe a “materially different apparatus,” but instead has merely suggested elements which a materially different apparatus might not include. Without a description of an allegedly, materially different apparatus, the Office Action fails to provide adequate “reasons and/or examples to support [its] conclusions.” MPEP 803. Specifically, the Office Action only identifies three elements which an allegedly, “materially different apparatus” may lack. Nevertheless, absent a description of the elements replacing “a transfer wheel, a star wheel, or a turret” in the apparatus envisioned by the Office Action, the Office Action fails to provide reasons why an apparatus lacking any of these elements would be material different or evidence that an apparatus lacking any of these elements would be materially different. Unless, of course, it is the Office Action’s contention that any apparatus lacking any of these elements regardless what they were replaced with would be a “materially different apparatus.”

In addition, the Office Action contends that “these inventions . . . have acquired separate status in the art as shown by their different classification.” Office Action, Page 2, Lines 16-18. This contention is unsupported by the facts. The Office Action itself notes that both the apparatus and process claims fall within the same class, namely, Class 53. According to the MPEP, when two allegedly separate inventions fall into the same class, the only way to show separate status in the art is “by citing patents which are evidence of such separate status.” MPEP 808.02(B). The Office Action fails to cite any such patents and, therefore, fails to support the

restriction requirement on the basis of classification alone. To the extent the Office Action relies on the differences in subclasses between the two allegedly separate inventions, Applicant maintains that distinction alone is insufficient to support this restriction. Moreover, it would not impose a serious burden on the Examiner to search two subclasses. Typically, examiners search more than one subclass in performing their searches for prior art for a single invention. The Office Action fails to demonstrate why searching both subclasses 235 and 473 in this application now would impose a serious burden on the Examiner. Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction requirement..

Conclusion:

Applicant respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

Dated: February 28, 2005

Respectfully submitted,
BAKER BOTTS L.L.P.
By _____
James B. Arpin
Registration No. 33,470

Baker Botts L.L.P.
The Warner, Suite 1300
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2400
Tel: (202) 639-7700
Fax: (202) 639-7890

JBA/dw